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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/972,833	11/18/97	PUTERKA	4030C

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EXAMINER  
LOVERING, R

ART UNIT	PAPER NUMBER
1721	16

DATE MAILED: 02/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

08/972,653

Applicant(s)

PUTERKA ET AL.

Examiner

LOVERING

Group Art Unit

1721

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☒ Responsive to communication(s) filed on SEPT. 17, OCT. 26 & DEC. 3, 1998
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 749
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 16 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bar-Joseph et al. CA 99:189761 (1983) "Spraying citrus plants with kaolin suspensions reduces colonization by the spiraea aphid", esp. abstract.
3. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Joseph et al. above in view of Marotta 3,159,536 of record.

While Bar-Joseph et al. may not specifically disclose the particle size distributions called for by the stated claims, it would have been obvious to one skilled in the art at the time applicants' invention was made to select such particle size distributions in the kaolin suspensions of Bar-Joseph et al. in view of the teachings of Marotta (column 7, lines 37-51).

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Joseph et al. above in view of Viba WO94/09626.

While Bar-Joseph et al. may not disclose the use of a low boiling organic liquid, it would have been obvious to one skilled in the art at the time applicants' invention was made to incorporate methanol in the kaolin suspensions of Bar-Joseph et al. in view of the disclosure of Viba (Table 1; and page 5, line 10) to facilitate evaporation or drying of the suspensions after their application.

5. Claims 1, 3-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Joseph et al.

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While Bar-Joseph et al. may not specifically disclose calcined kaolin, it would have been obvious to one skilled in the art at the time applicants' invention was made to use calcined kaolin in lieu of ordinary kaolin in the suspensions of Bar-Joseph et al. with a reasonable expectation of success, since calcined kaolin is commercially available (as admitted in paragraph bridging pages 7 and 8 of the specification), in the absence of a showing of improved results using calcined kaolin vs. ordinary kaolin.

6. Claims 2, 6-8 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Joseph et al. as applied to claims 1, 3-5 and 9 above, and further in view of Marotta above.

Bar-Joseph et al. applies as in the preceding paragraph. While Bar-Joseph et al. may not specifically disclose the particle size distributions called for by the stated claims, it would further have been obvious to one skilled in the art at the time applicants' invention was made to select such particle size distributions in the above-modified kaolin suspensions of Bar-Joseph et al. in view of the teachings of Marotta (loc cit).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Joseph et al. in view of Marotta as applied to claims 2, 6-8 and 12-14 above, and further in view of Vita above.

While the combination of Bar-Joseph et al. and Marotta may not disclose the use of a low boiling organic liquid, it would further have been obvious to one skilled in the art at the time applicants' invention was made to incorporate methanol in the kaolin suspensions of Bar-Joseph et al., modified as above by Marotta, in view of the disclosure of Vita (loc cit) to facilitate evaporation or drying of the suspensions after their application.

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8. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Joseph et al. as applied to claims 1, 3-5 and 9 above, and further in view of ~~Viba~~ <sup>Viba</sup> above.

Bar-Joseph et al. applies as in paragraph 5 above. While Bar-Joseph et al. may not disclose the use of a low boiling organic liquid, it would further have been obvious to one skilled in the art at the time applicants' invention was made to incorporate methanol in the suspensions of Bar-Joseph et al. containing calcined kaolin in view of the disclosure of ~~Viba~~ <sup>Viba</sup> (loc cit) to facilitate evaporation or drying of the suspensions after their application.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-36 and 38 of copending Application No. 08/972,648. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because the instant claims at least overlap the stated claims of the '648 application in having kaolins and calcium carbonates in common therewith.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

12. Any inquiry concerning this communication should be directed to Examiner Lovering at telephone number (703) 308-0443.

Lovering:cb  
Primary Examiner

February 3, 1999

*Richard D. Lovering*  
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